

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/771,633
ATTORNEY DOCKET NO. Q62025

REMARKS

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, Korean Patent Application No. 00-34813 dated June 23, 2000, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on January 23, 2002, thereby confirming that the listed references have been considered. It appears that the Patent Office has combined the PTO/SB/08 A & B form submitted on January 23, 2002 with the PTO/SB/08 A & B form submitted on March 2, 2004. The publication entitled "Media Translation Based on QoS Requirement of Devices and Services" by Yura *et al.*, which was listed on the PTO/SB/08 A & B form submitted on March 2, 2004, has been hand-entered into the PTO/SB/08 A & B form submitted on January 23, 2002 by the Patent Office.

Claims 1-5 have been examined on their merits.

Applicants herein add new claims 6-9. Support for new claims 6-9 can be found in the originally filed specification. No new matter has been added. Entry and consideration of the new claims 6-9 is respectfully requested.

Claims 1-9 are all the claims presently pending in the application.

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1. Claim 4 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Alonso *et al.* (U.S. Patent No. 6,184,878). Applicants traverse the rejection of claim 4 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). For anticipation to exist, there must be no difference between the claimed invention and the reference disclosure, as that reference would be understood by one of ordinary skill in the art. *See Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); *see also, Crown Operations Intn’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, “an anticipating reference must describe the [claimed] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1998) (citing *In re Spada*, 911 F.2d 705,

708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Alonso *et al.* fails to teach or suggest a method that comprises at least receiving a selected VOD service in a VOD terminal, wherein the VOD service comprises non-video content converted using wireless markup language (WML), as recited in claim 1. There is no teaching or suggestion at all in Alonso *et al.* that non-video content (*e.g.*, audio data) is converted using wireless markup language. Instead, Alonso *et al.* disclose that, for example, audiovisual files are converted into MPEG1, MPEG2, ATM, etc. type formats. Furthermore, Alonso *et al.* do not teach or suggest converting non-video content into any sort of markup language. For example, data in HTML format is converted is converted into a video “page” prior to transmission. In contrast, WML was designed for low-bandwidth, small-display devices. WML is based on XML, a markup language that has the ability to describe data, as opposed to HTML, which is used to describe the display of data. Applicants’ invention advantageously uses WML to convert non-video content for a selected VOD service.

Based on the foregoing reasons, Applicants submit that Alonso *et al.* fail to teach or suggest all of the claimed elements as arranged in claim 4. Therefore, under *Hybritech* and *Richardson*, Alonso *et al.* clearly cannot anticipate the present invention as recited in independent claim 4. Thus, Applicants submit that claim 4 is allowable, and respectfully request that the Patent Office withdraw the § 102(e) rejection of claim 4.

2. Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Alonso *et al.* Applicants traverse the rejection of claims 1, 3 and 5, and insofar as the rejection might apply to new claims 6-9, for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the

motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.*

Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d at 1316-1317 (*citing B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996)); *see also, Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

Alonso *et al.* fail to teach or suggest at least an encoder that encodes a first type of content into one format type and a converter that converts a second type of content into another

format type, wherein at least a portion of the first content type or the second content type is converted using wireless markup language, as recited in claim 1. As noted above with respect to the rejection of claim 4, there is no teaching or suggestion at all in Alonso *et al.* that certain types of content (*e.g.*, audio data) are converted using wireless markup language. Instead, Alonso *et al.* disclose that, for example, audiovisual files are converted into MPEG1, MPEG2, ATM, etc. type formats, none of which employ wireless markup language. For example, data in HTML format is converted is converted into a video “page” prior to transmission. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to modify Alonso *et al.* Since Alonso *et al.* already disclose the conversion of audiovisual files are converted into MPEG1, MPEG2, ATM, etc. type formats and data in HTML format is converted is converted into a video “page” prior to transmission, there is no motivation for one of skill in the art to add further data conversions using WML. Applicants submit that there would be no motivation to modify Alonso *et al.*, to fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that Alonso *et al.* fail to disclose all of the claimed elements as arranged in claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claim 3 is allowable as well, at least by virtue of its dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 1 and 3.

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Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alonso *et al.* Claim 4 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Since claim 5 depends upon claim 4, Applicants submit that claim 5 is allowable at least by virtue of its dependency from claim 4. Applicants respectfully request that the rejection of claim 5 under 35 U.S.C. § 103(a) be withdrawn.

3. Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Alonso *et al.* in view of Haugli *et al.* (U.S. Patent No. 5,991,279). Applicants traverse the rejection of claim 2 for at least the reasons discussed below.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Alonso *et al.* in view of Haugli *et al.* Since claim 2 depends upon claim 1 and since Haugli *et al.* does not cure the deficient teachings of Alonso *et al.* with respect to claim 1, Applicants submit that claim 2 is allowable at least by virtue of its dependency from claim 1. Applicants respectfully request that the rejection of claim 2 under 35 U.S.C. § 103(a) be withdrawn.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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